REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of October 22, 2008 (Office Action). As this response is filed within the three-month statutory period, no fee is believed to be due. However, the Examiner is expressly authorized to charge the any fees for maintaining pendency of this Application to Deposit Account No. 50-0951.

Claims Rejections – 35 USC § 103

Claims 1-2 and 4-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2002/0169840 to Sheldon, et al. (hereinafter Sheldon), and in view Non-Patent Literature "RE: too many "Out of Office AutoReply" by Lemson (hereinafter Lemson) and in further view of U.S. Patent No. 6,393,494 to Dieterman (hereinafter Dieterman) and European Patent Office Published Application 0 605 106 to Hosmer (hereinafter Hosmer). Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sheldon in view of Lemson and Dieterman, and in further view of Hosmer and Non-Patent Literature "Managing instant messaging users" by Boyce (hereinafter Boyce).

Although Applicant respectfully disagrees with the rejections, Applicant has slightly modified the language of Claim 1 in an effort to even more clearly define the present invention.

Aspects of Applicants' Invention

It may be helpful to reiterate certain aspects of Applicant's invention prior to addressing the cited references. One embodiment of the invention, as typified by amended Claim 1, is a method of communicating over a communications network.

The method can include defining a first list specifying one or more electronic message sources to which automated reply electronic messages are allowed to be sent, the first list being determined by a user of an electronic communication client and stored in a first database communicatively linked to the electronic communication client; defining a second list specifying one or more electronic message sources to which automated reply electronic messages are allowed to be sent, the second list being determined by a system administrator and stored in a second database communicatively linked to the electronic communication client and to an electronic communication server; and defining a set of rules specifying which one of the first list and the second list dominates in an event of a conflict.

The method also can include receiving an electronic message from a source; after the electronic message being received by the user, comparing the source of the received electronic message with the sources in the first and second stored lists; sending an automated reply electronic message if the source matches a source in both the first and second lists; not sending an automated reply electronic message if the source does not match any source in the first and second lists; and determining whether or not to send an automated reply electronic message using the set of rules specifying which one of the first list and the second list dominates in the event of a conflict if the source only matches a source in one of the first and second lists.

See, e.g., Specification, paragraphs [0018], [0023] and [0033]-[0036].

The Claims Define Over The Prior Art

Electronic mail (e-mail) and other electronic messaging systems, including instant messaging, have become essential tools for modern communication. Users have come to rely on such systems as a primary means of communication with co-workers and social contacts alike. This increased reliance has led to the development of features that attempt to make electronic communications even more dependable. One such feature is the automated reply, or auto-reply function within e-mail systems. Conventional e-mail systems can be instructed to respond automatically to incoming e-mails using a programmed message. Typically, this feature allows a receiving e-mail system to confirm receipt of an e-mail, while also informing the sender that the user will be unavailable for a period of time. See Specification, paragraph [0002].

The unsolicited e-mail industry, or so called "spam" industry, has experienced significant growth, paralleling that of e-mail itself. Valid e-mail addresses are valuable commodities within the spam industry as each e-mail address represents a potential customer. Spammers attempt to maximize unsolicited e-mail sent to valid e-mail addresses and minimize the e-mail sent to invalid e-mail addresses in an effort to conserve resources and increase profitability. E-mail addresses, however, can be easily changed and frequently modified, deleted, or created. As a result, it can be difficult for spammers to maintain a current list of valid e-mail addresses. One way in which spammers check the validity of an e-mail and other network addresses is by monitoring for a response to an unsolicited e-mail. Many unsolicited e-mails invite the recipient to select a hyperlink or send a reply e-mail to a particular address to either obtain more information, purchase a product, or to be removed from the spammer's solicitation list. When a response is received, the spammer affirms the validity of the responder's e-mail address. See Specification, paragraphs [0003] and [0004].

When a user invokes an auto-reply function, for example while the user is on vacation, the e-mail system responds to any received e-mails using an automatically generated, programmed message. The auto-reply function remains active for the duration specified by the user or administrator, or until deactivated. If a received e-mail is an unsolicited e-mail or considered to be spam, a reply sent from the recipient serves only to confirm the validity of the recipient's e-mail address to the spammer. Typically, this means that the recipient can look forward to receiving additional unsolicited e-mail from the same source or spammer. See Specification, paragraph [0005].

The present invention provides a solution for limiting the amount of unsolicited electronic messages, whether e-mail, instant messages, or any other type of electronic message, received by users. According to the present invention, users can invoke an automated reply feature within an electronic communication system. A list is developed that specifies one or more allowable sources of electronic messages, whether entire domains, individual addresses, groups of addresses, or the like, to which automated replies can be sent. Thus, when the automated reply feature is invoked, automated replies are sent only in response to received electronic messages from sources specified in the list of allowable sources of electronic messages. See Specification, paragraph [0006].

As already discussed in the previous response, a list of "accepted" e-mail addresses as disclosed in Sheldon is different from a list of "automated reply" e-mail addresses in the present invention. "Accepted" e-mail addresses refer to addresses from which the user wishes to accept e-mails, whereas "automated reply" e-mail addresses refer to addresses to which automated reply electronic messages are allowed to be sent. It is noted that an e-mail address may be in the list of "accepted" e-mail addresses, but not necessarily in the list of e-mail addresses to which an auto-reply message is allowed to be sent. In other words, a user may wish to receive messages from a particular e-mail address, but not to send an auto-reply message to this e-mail address.

It was asserted in the Office Action that the Examiner recognizes that the Applicant attempts to point out that there could be a list of accepted e-mail addresses that does not necessarily correspond to the list of accepted e-mail addresses for auto-reply messages; however, this relation is not clarified with corresponding claim language in the claim itself. The claim recites "receiving an electronic message from a source" but does not specify that it is received by the recipient. Rather, the mail server could receive the electronic message and then make a judgment regarding the electronic message. This leaves the Examiner's interpretation as valid one.

In order to even more clearly define the present invention, the language of Claim 1 has been modified to recite "after the electronic message is received by the user, comparing the source of the received electronic message with the sources in the first and second stored lists."

It was also asserted in the Office Acton that Lemson directly relates to an automated reply list, as Lemson discloses that "The intent is to allow the administrator to be able to set a policy of "no out-of-office messages to random people on the Internet, but does allow them to go to our certain partners"." (see pg. 1, final paragraph, continuing on to pg. 2).

However, as already discussed in the previous response, although Lemson discloses that an administrator can determine which "Internet e-mail domains" may receive auto-forward, auto-reply, and out-of-office messages, Lemson does not disclose the concept of an "automated reply" list of the present invention. It is noted that Lemson discloses that in both Exchange 5.5 and Exchange 2000, there is a "default" setting, and a per-domain setting (see pg. 2, paragraph 2), but not an "automated reply" list listing electronic message sources to which automated reply electronic messages are allowed to be sent and especially not a first list by a user and a second list by the administrator and a set of rules specifying which one of the first list and the second list dominates in an event of a conflict, as in the present invention.

It was further asserted in the Office Acton that Applicant argues that Hosmer does not disclose determining which of two automated reply lists should apply; however, the Examiner has addressed the limitation using multiple prior art references and Hosmer is not relied upon alone to reject the relevant subject matter.

However, it is noted that Hosmer was clearly relied on by the Examiner as disclosing defining a set of rules specifying which among a first list and a second list dominates if a conflict occurs (see the first paragraph on page 10 of the Office Action). It is also noted that Applicant has not attacked the references individually where the rejections are based on combinations of references. Rather, Applicant has argued that the references do not disclose what they were alleged to disclose and thus a combination of the references also does not disclose the relevant limitations. If certain limitations are not disclosed by any of the cited references, it is reasonable to conclude that a combination of the references also does not disclose those limitations.

As already discussed in the previous response, Hosmer generally discloses a method of processing a request subject to conflicting policies. However, Hosmer has nothing to do with determining which "automated reply" list should apply if a source only matches one of the two lists. It is also noted that in the present invention, whether an automated reply should be sent to the source is automatically determined upon receiving an email from the source by the user without a request.

In summary, none of the cited references disclose the aspect of the present invention, namely defining an "automated reply" list of sources to which automated reply electronic messages are allowed to be sent by both the user and the administrator, and upon receiving an electronic message from a source, determining whether to send an automated reply to the source, as recited in Claim 1 of the instant application.

Accordingly, the cited references, alone or in combination, fail to disclose or suggest each and every element of Claim 1, as amended. Applicant therefore respectfully submits that amended Claim 1 defines over the prior art. Furthermore, as each of the remaining claims depends from Claim 1 while reciting additional features, Applicant further respectfully submits that the remaining claims likewise define over the prior art.

Applicant thus respectfully requests that the claim rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Applicant believes that this application is now in full condition for allowance, which action is respectfully requested. Applicant respectfully requests that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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Date: December 3, 2008

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